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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,278	09/08/2003	Valerie De La Poterie	230255US0	7136

22850 7590 12/19/2008
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

VENKAT, JYOTHSNA A

ART UNIT	PAPER NUMBER
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1619

NOTIFICATION DATE	DELIVERY MODE
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12/19/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/656,278	Applicant(s) DE LA POTERIE ET AL.	
	Examiner JYOTHSNA A. VENKAT	Art Unit 1619	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 32-34 and 36-62 is/are pending in the application.
- 4a) Of the above claim(s) 39-44 and 59-62 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 32-34, 36-38 and 45-58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Receipt is acknowledged of amendment and remarks filed on 9/17/08. Claim 35 has been canceled as per applicant's amendment dated 9/17/08. Claims 32-34 and 36-62 are pending in the application.

Claims 39-44 are withdrawn as being drawn to non-elected species and claims 59-62 are withdrawn as being drawn to non-elected invention.

Claims 32-34, 36-38 and 45-58 are currently examined in the application. Election of species drawn to Tacky wax is hereby withdrawn.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

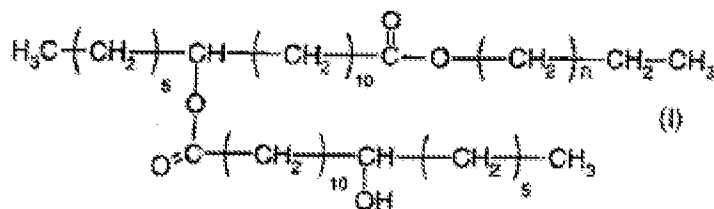
The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 32-34, 36-38 and 45-58 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. **This is written description rejection.**

The specification discloses tackifying wax having a tack of greater than or equal to 0.7 N.s and a hardness of less than or equal to 3.5 MPa drawn to formula (I) such as Kester Wax K 82 P, and Kester Wax 80 P at page 6 of the specification. See below for formula I.

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As tackifying wax it is possible to use a C₂₀-C₄₀ alkyl (hydroxystearyloxy)stearate (the alkyl group containing 20 to 40 carbon atoms), in particular
 20 a C₂₀-C₄₀ alkyl 12-(12'-hydroxystearyloxy)stearate, of formula (I):



25 in which n is an integer ranging from 18 to 38, or a mixture of compounds of formula (I).

Such a wax is sold in particular under the names Kester Wax K 82 P and Kester Wax K 80 P by Koster Keunen.

However tacky wax also includes the following waxes. These are:

1. Bayberry wax
2. Hydrogenated jojoba wax
3. Candelillia wax
4. Carnauba wax
5. Hydrogenated rice bran wax
6. Japan wax
7. Jojoba butter
8. Jojoba oil
9. Lanolin wax
10. Microcrystalline wax

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11. Mink wax
12. Montan acid wax
13. Montan wax
14. Ouricurry wax
15. Ozokerite wax
16. Rice bran wax
17. Shellac wax
18. Synthetic wax an
19. Synthetic Beeswax (no formula)

The specification provides insufficient written description to support the genus encompassed by the claim having a tacky wax of tack of greater than or equal to 0.7 N.s and a hardness of less than or equal to 3.5 MPa and the composition having the tackifying wax that has the claimed adhesion profile claimed in claim 32.

Vas-Cath Inc. v. Mahurkar, 19 USPQ2d 1111, makes clear that "applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention. The invention is, for purposes of the 'written description' inquiry, whatever is now claimed." (See page 1117.) The specification does not "clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed." (See Vas-Cath at page 1116.)

The skilled artisan cannot envision which waxes are tacky and would possess the property described in claim 1 with respect to tack and adhesion profile. Adequate written description requires more than a mere statement that it is part of the invention. See *Fiefs v. Revel*,

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25 *USPQ2d* 1601, 1606 (CAFC 1993) and *Amgen Inc. V. Chugai Pharmaceutical Co. Ltd.*, 18 *USPQ2d* 1016. In *Fiddes v. Baird*, 30 *USPQ2d* 1481, 1483, claims directed to mammalian FGF's were found unpatentable due to lack of written description for the broad class. The specification provided only the bovine sequence. Finally, *University of California v. Eli Lilly and Co.*, 43 *USPQ2d* 1398, 1404, 1405 held that: "...To fulfill the written description requirement, a patent specification must describe an invention and do so in sufficient detail that one skilled in the art can clearly conclude that "the inventor invented the claimed invention." *Lockwood v. American Airlines, Inc.* , 107 F.3d 1565, 1572, 41 *USPQ2d* 1961, 1966 (1997); *In re Gosteli* , 872 F.2d 1008, 1012, 10 *USPQ2d* 1614, 1618 (Fed. Cir. 1989) (" [T]he description must clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed."). Thus, an applicant complies with the written description requirement "by describing the invention, with all its claimed limitations, not that which makes it obvious," and by using "such descriptive means as words, structures, figures, diagrams, formulas, etc., that set forth the claimed invention." *Lockwood* , 107 F.3d at 1572, 41 *USPQ2d* at 1966.

The specification meets written description with respect claim 1 composition using formula I drawn to mascara meeting the adhesion profile and not keratin fiber composition using any tackifying wax wherein the keratin fiber composition is a make-up base, a make-up composition, a top coat composition applied over make-up or a keratin fiber care or treatment composition.

Therefore, only the tacky wax having formula I in mascara composition shown to possess the required property described in claim 1 and meet the written description provision of 35 USC § 112, first paragraph . The specification does not teach any other waxes that are tacky

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actually possessing a tack of greater than or equal to 0.7 N.s and a hardness of less than or equal to 3.5 MPa, and thus formula I disclosed in the specification is not representative of the genus because the genus is highly variant. The specification does not teach any other keratin fiber compositions using waxes that are tacky actually possessing a tack of greater than or equal to 0.7 N.s and a hardness of less than or equal to 3.5 MPa, and thus formula I disclosed in the specification in mascara is not representative of the genus drawn to any keratin fiber because the genus is highly variant. Applicant is reminded that Vas-Cath makes clear that the written description provision of 35 USC § 112 is severable from its enablement provision. (See page 1115.)

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 56 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

What is meant by “ keratin fiber care and keratin fiber treatment composition”? Is it care composition for skin or nail or hair . Specification does not describe these care compositions.

Response to Arguments

Applicant's arguments with respect to claims 32-38 and 45-58 under 35 U.S.C. 103 as being obvious over U.S. Patent 5,985,295 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

Claims 32-34, 36-38 and 45-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of 5,985,298 ('298) and U.S. Patents 5,783,176 ('176).

Patent '298 teaches cosmetic compositions. See col.5, ll 41-65 for mascara compositions and these compositions have wax. The compositions have volatile solvent and non-volatile oil, film former and emulsifier. The waxes include Kester wax, which is also known as synthetic bees wax. Example 2 has bees wax and synthetic wax instead of synthetic bees wax. The example drawn to mascara has water (solvent). Patent also teaches other cosmetic compositions and this has ethyl alcohol (claims 47-48). The weight percent of the solvent is also within the claimed range. Mascara composition has film former, which is polyethylene. Example 2 has 4 types of waxes. Patent also teaches other cosmetic compositions and this has ethyl alcohol (claims 47-48). The weight percent of the solvent is also within the claimed range. See also col.6, line 50 through col.7, line 32.) See all the examples drawn to various cosmetic formulations (claim 56). The combination of volatile oil and non volatile solvent belongs to claimed fatty phase. See col.2, line 20 through col.4, line 21 for fatty phase. see col4, ll 48-50, col.5, ll 34-62. The weight percent of volatile solvent and non-volatile oil taught by the patent is within the weight percent claimed for the volatile oil and non-volatile oil. See col. 4, ll 22-24 for the various cosmetic products. Patent also teaches film formers at paragraph bridging col.s 5-6 and teaches that various film formers disclosed in CTFA handbook can be used (claims 49-51). Patent at col.5, ll 17-32 teaches colorants and the weight percent of the colorants (claims 52-54). Patent under example 2 teaches mascara. This has ammonium hydroxide, silica, methyl parabens (neutralizing agents, fillers, preservatives of claim 55) The difference between the patent and the

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instant application is patent does not disclose limitation of claim 38 for tacky wax. However, patent '176 teaches tacky wax claimed in instant application as ester. See the abstract, see col.3, ll 30 through col.4, line 65 and see the paragraph bridging col.s 4-5. Patent at col.5, ll 35-45 teaches surfactants and at col.5, ll 52-61 teaches solvents and at col.8, ll 39-65 teaches conventional cosmetic additives. See the examples.

Accordingly, it would be obvious to one of ordinary skill in the art at the time the invention was made to prepare compositions of patent '298 and substitute synthetic beeswax of patent '196 for bees wax or synthetic wax taught in the mascara compositions. One of ordinary skill in the art would substitute the functional equivalents expecting that the synthetic beeswax of patent '176 can also be used in composition. This is a prima facie case of obviousness.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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Claims 32-34, 36-38 and 45-58 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 36-38, 40 and 42-44 of copending Application No. 10/656,201. Although the conflicting claims are not identical, they are not patentably distinct from each other because both the instant application and copending application are drawn to compositions comprising the same tacky wax, film former, solvent, colorant, and fatty phase. The difference is in copending application the compositions are in the form of mascara and in instant application the claims are drawn to keratin fiber make up compositions. The genus (keratin fiber makeup) anticipates claims of co-pending application drawn to species (mascara).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 32-34, 36-38 and 45-58 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-31 and 73-100 of copending Application No. 10/654,887. Although the conflicting claims are not identical, they are not patentably distinct from each other because there is overlap of subject matter with respect to compositions claimed in the co-pending application and the instant application. Both the instant application and co-pending application use tacky wax, film forming polymer and other additives. There is overlap of subject matter in the instant and co-pending application.

Although 10/654, 887 include an additional requirement, i.e., additional waxes, emulsifiers, the use of the claim language "comprising" in instant application permits these additional requirements. The transitional term "comprising", which is synonymous with "including," "containing," or "characterized by," is inclusive or open- ended and does not

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exclude additional, unrecited elements or method steps. See, e.g., *Mars Inc. v. H.J. Heinz Co.*, 377 F.3d 1369, 1376, 71 USPQ2d 1837, 1843 (Fed. Cir. 2004) ("like the term comprising,' the terms containing' and mixture' are open-ended."). *Invitrogen Corp. v. BiocrestMfg., L.P.*, 327 F.3d 1364, 1368, 66 USPQ2d 1631, 1634 (Fed. Cir. 2003) ("The transition comprising' in a method claim indicates that the claim is open-ended and allows for additional steps."); *Genentech, Inc. v. Chiron Corp.*, 112 F.3d 495, 501, 42 USPQ2d 1608, 1613 (Fed. Cir. 1997) ("Comprising" is a term of art used in claim language which means that the named elements are essential, but other elements may be added and still form a construct within the scope of the claim.). Using the transitional phrase "consisting of" excludes any element, step, or ingredient not specified in the claim. *In re Gray*, 53 F.2d 520, 11 USPQ 255 (CCPA 1931); *Ex parte Davis*, 80 USPQ 448, 450 (Bd. App. 1948).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 32-34, 36-38 and 45-58 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-24 and 79-107 of copending Application No. 10/654,907. Although the conflicting claims are not identical, they are not patentably distinct from each other because there is overlap of subject matter with respect to compositions claimed in the co-pending application and the instant application. Both the instant application and co-pending application use tacky wax, film forming polymer and other additives in the. There is overlap of subject matter in the instant and co-pending application.

Although 10/654, 907 include an additional requirement, i.e., additional waxes, emulsifiers, the use of the claim language "comprising" in instant application permits these

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additional requirements. The transitional term "comprising", which is synonymous with "including," "containing," or "characterized by," is inclusive or open-ended and does not exclude additional, unrecited elements or method steps. See, e.g., *Mars Inc. v. H.J. Heinz Co.*, 377 F.3d 1369, 1376, 71 USPQ2d 1837, 1843 (Fed. Cir. 2004) ("like the term comprising,' the terms containing' and mixture' are open-ended."). *Invitrogen Corp. v. BiocrestMfg., L.P.*, 327 F.3d 1364, 1368, 66 USPQ2d 1631, 1634 (Fed. Cir. 2003) ("The transition comprising' in a method claim indicates that the claim is open-ended and allows for additional steps."); *Genentech, Inc. v. Chiron Corp.*, 112 F.3d 495, 501, 42 USPQ2d 1608, 1613 (Fed. Cir. 1997) ("Comprising" is a term of art used in claim language which means that the named elements are essential, but other elements may be added and still form a construct within the scope of the claim.). Using the transitional phrase "consisting of" excludes any element, step, or ingredient not specified in the claim. In *re Gray*, 53 F.2d 520, 11 USPQ 255 (CCPA 1931); *Ex parte Davis*, 80 USPQ 448,450 (Bd. App. 1948).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A. VENKAT whose telephone number is 571-272-0607. The examiner can normally be reached on Monday-Friday, 10:30-7:30:1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL WOODWARD can be reached on 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JYOTHSNA A VENKAT /
Primary Examiner, Art Unit 1619